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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/987,740    12/09/97    BOYER

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EXAMINER
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LM02/1112

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PIERCE, I	
ART UNIT	PAPER NUMBER

2756

*8*

DATE MAILED:

11/12/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/987,740**

Applicant(s)  
**Boyer et al.**

Examiner  
**Ivan Pierce**

Group Art Unit  
**2756**



☒ Responsive to communication(s) filed on Jan 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three, 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-60 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-60 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 6 and 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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This application has been examined. Original claims 1-60 are pending. The objections and rejections cited are as stated below.

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Logan et al. Logan et al., in U.S. Patent 5721827, disclose a method or providing e-mail message reminders of scheduled television events to a user at a multimedia system over the Internet using an Internet television program guide system, *ABSTRACT, Fig 1*, the method comprising the steps of:
  - (a) providing television program listings over the Internet, *col 1 lines 5-36, Fig 1; radio and television program guides and content are electronically distributed to individual subscribers across the Internet;*
  - (b) selecting a television program from the television program listings provided over the Internet; *col 1 line 38-col 2 line 29; subscribers select television programs directly or by subscriber preferences which are used to match the attributes of subscribers with program listings; and*

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© providing e-mail reminders or *messages* to the multimedia system over the Internet that remind the user when the television program is to be broadcast, *col 20 line 31 - col 21 line 9; In addition to notifying subscribers of upcoming program segments, annotations to program listings are bookmarked for future reference and for forwarding to other email addresses, col 14 line 42 - col 15 line 14. Public comments on upcoming program segments can be provided directly to email subscribers, col 41 lines 8-51, with text or audio attachments, col 42 lines 10-19.*

*An electronic information distribution system is disclosed in which entertainment content is scheduled and provided to subscribers. Program segments are listed and matched with subscriber preferences for broadcast, while comments and messages from the subscribers are managed by hosts and retransmitted to other subscribers according to selection files, Fig 5. Program messages can be issued before, during or after a broadcast to remind the subscriber of upcoming segments, Fig 7, col 37 lines 14-26. By this rationale, claims 1 and 20 are rejected.*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. Logan et al., in U.S. Patent 5721827, disclose the method defined in claim 20 further

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comprising the steps of providing e-mail reminder or *message* options in which the user selects to order e-mail *messages*, *col 6 line 45 - col 10 line 5*; *Email messages can be requested according to subscriber interest using HTML pages, col 40 line 5 - col 44 line 30, containing selectable user choices for the subscriber, col 4 line 14 - col 10 line 5, which provide profiling information used to match the subscriber attributes with program listings using such factors as viewing duration, frequency, date and time, title, etc., col 19 line 10 - col 23 line 67. Pay-per-view or subscription costs, program schedule, col 10 line 6 - col 11 line 51, and program controls provide the subscriber command options for organizing email messages and billing parameters used to develop subscriber profiles, col 12 line 16 - col 16 line 56. By this rationale, claims 2-17 and 21-39 are rejected.*

6. Logan et al. additionally disclose the system defined in claim 1 further comprising means for providing a user or *subscriber* preference profile option which the user selects to order an e-mail *message* by selecting from various e-mail *message* preferences, *col 27 line 37 - col 29 line 19. Program format options used to select segments of interest to the subscriber are associated with content descriptors of various kinds. A genre or subject collection can be gathered by hypertext references to local or distributed resources which totally or partially provide content in accordance with subscriber choices, col 29 line 40 - col 32 line 49, and which modify HTML pages in response to approximate or exact subject/topic names, email comments and annotations, col 40 line 5 - col 44 line 30. By this rationale, claims 40-60 are rejected.*

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

These include U.S. Patents:

5889950	Kuzma	3/30/99
5619274	Roop et al.	4/8/99
5576755	Davis et al.	11/19/96
5475835	Hickey	12/12/95

8. Any inquiry concerning this communication should be directed to Ivan Pierce at (703) 308-1058 or his supervisor Frank Asta at telephone number (703) 305-3817. The examiner can normally be reached on Mondays-Fridays from 8:30 A.M. to 5:00 P.M.

9. The fax number for this Group is (703) 308-9356. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group whose telephone number is (703) 305-3900.

  
**Ivan C. Pierce, III**  
**EXAMINER**  
**ART UNIT 2756**

  
**FRANK J. ASTA**  
**SUPERVISORY PATENT EXAMINER**  
**GROUP 2700**